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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,400	04/26/2001	Takanori Nishimura	275754US6	3418
22850	7590	09/12/2007	EXAMINER	
OBLOON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			PARK, CHAN S	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			2625	
NOTIFICATION DATE		DELIVERY MODE		
09/12/2007		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/843,400	NISHIMURA, TAKANORI
Examiner	Art Unit	
CHAN S. PARK	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 May 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,4-10,13-19,22-28 and 31-38 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,4-10,13-19,22-28 and 31-38 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN  
PRIMARY EXAMINER

*Douglas Q. Tran*

*Chan S. Park*

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's Appeal Brief was received on 5/14/07, and has been entered and made of record. Currently, **claims 1, 4-10, 13-19, 22-28 and 31-38** are pending.

***Response to Arguments***

2. In view of the appeal brief filed on 3/15/05, PROSECUTION IS HEREBY REOPENED.

New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 7, 8, 10, 13, 16, 17, 19, 22, 25, 26, 28, 31, 32, 34, 35, 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 recites the limitation "said E-mail information" in line 13. It is unclear if the transmission unit always transmits said original Email information, which is not converted, even if said converting unit converts the Email information.

4. With respect to claims 10, 19, 28, 31, 32, 37 and 38, arguments analogous to those presented for claim 1, are applicable.

5. With respect to claim 4, it recites the limitation "if said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file". It is unclear how a device is matched with a file. What exactly is being matched with the attached file? Furthermore, it is unclear if there is a difference between matching with the E-mail information (claim 1) and matching with only the attached file (claim 4). Clarification/explanation from the Specification is respectfully requested.

6. With respect to claim 13, 22, 31 and 32, arguments analogous to those presented for claim 4, are applicable.

7. With respect to claims 7 and 8, the claims recite the limitation "the information accommodating capability of said reception terminal... includes a maximum size of the E-mail information, ... the maximum file size of the attached file". The claims appear to recite that the information accommodating capability is based on the E-mail information to be transmitted. Is not that capability information already set and stored regardless what the received/transmitted E-mail size is? If the capability information is based on the E-mail information, isn't the capability information always matched to the E-mail information? Furthermore, does the E-mail information include a plurality of files? How are the maximum size of the E-mail and the maximum file size of the attached file determined? Clarification/explanation from the Specification is respectfully requested.

8. With respect to claims 16, 17, 25, 26, 34 and 35, arguments analogous to those presented for claims 7 and 8, are applicable.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 10, 15, 19, 24, 28, 31, 32, 33, 37 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Friend U.S. Patent No. 6,728,757.

Art Unit: 2625

9. With respect to claim 1, Friend discloses an information processing apparatus configured to transmit an E-mail information (col. 2, lines 64-67), said E-mail information including an E-mail message body and an attached file (col. 3, lines 16-19) to a reception terminal, the apparatus comprising:

an accommodating capability verifying unit configured to verify an information accommodating capability in at least a reception terminal or in a communication system encompassing said reception terminal, based only on a domain of an E-mail address used in sending the E-mail information to said reception terminal (col. 3, lines 1-40 & figs. 5~6);

an information converting unit configured to convert the E-mail information into a format matching the information accommodating capability in said reception terminal or in said communication system encompassing said reception terminal, if the information accommodating capability in said reception terminal or in said communication system encompassing said reception terminal is not matched to said E-mail information (col. 3, lines 1-40); and

a transmission unit configured to transmit said E-mail information (sending the unconverted email to one of the plurality recipients in col. 3, lines 1-40 & col. 4, lines 39-46).

10. With respect to claim 6, Friend discloses the information processing apparatus according to claim 1, wherein the attached file is an image file (col. 3, lines 16-19).

11. With respect to claims 10, 19, 28, 31, 32, 37 and 38, arguments analogous to those presented for claim 1, are applicable.

12. With respect to claims 15, 24 and 33, arguments analogous to those presented for claim 6, are applicable.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 7, 13, 14, 16, 22, 23, 25, 31, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friend as applied to claims 1, 6, 10, 15, 19, 24, 28 and 33 above, and further in view of Kakimoto U.S. Patent No. 6,775,688.

13. With respect to claim 4, Friend does not expressly disclose the apparatus of claim 1 wherein, if said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit is configured to include in the E-mail information a statement of a method enabling a user of said reception terminal to confirm the contents of said attached file.

However, Kakimoto discloses an information processing apparatus (Fig 1) wherein, if said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit is configured to include in the E-mail information a statement of a method enabling a user of said reception terminal to confirm the contents of said attached file (col. 2, line 27-33, a link to a network where the specified data is stored is distributed to the

desired destinations). By clicking on a link sent to the reception terminal, distributed data can be accessed when the information accommodating capability is not conducive to the data sent. This would be considered a method enabling a user of said reception terminal to confirm the contents of said file information.

The Friend and the Kakimoto Patents are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to inform the reception terminal of the use of an access link to a network as specified in the Kakimoto Patent in order to access data from a reception terminal not capable of accommodating the data at the actual destination of the reception terminal, as specified in Friend.

The suggestion/motivation for doing so would have been to allow the user of the reception terminal to access information even though the reception terminal E-mail cannot accommodate the data designated to be transmitted.

Therefore it would have been obvious to combine the Kakimoto Patent with the Friend Patent in order to obtain the invention in claim 4.

14. With respect to claim 5, Friend does not expressly disclose that if the said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit sends accessing information to means for saving said attached file in said E-mail as a method enabling the confirmation of the contents of said attached file.

However, Kakimoto discloses an information processing apparatus (Fig 1) that if the said reception terminal or said communication system encompassing said reception terminal is not matched to the attached file, said information converting unit sends accessing information to means for saving said attached file in said E-mail as a method enabling the confirmation of the contents of said attached file. (Col 2 Lin 27-33, a link to a network where the specified data is stored is distributed to the desired destinations so that the data can be accessed.)

The Friend and the Kakimoto Patents are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to inform the reception terminal of the use of an access link to a network as specified in the Kakimoto Patent in order to access data from a reception terminal not capable of accommodating the data at the actual destination of the reception terminal, as specified in Friend.

The suggestion/motivation for doing so would have been to allow the user of the reception terminal to access information even though the reception terminal E-mail cannot accommodate the data designated to be transmitted.

Therefore it would have been obvious to combine the Kakimoto Patent with the Friend Patent in order to obtain the invention in claim 5.

15. With respect to claim 7, Friend further discloses the information processing apparatus according to claim 1 wherein the information accommodating capability of

said reception terminal or said communication system encompassing said reception terminal includes a format of the attached file. (Col 5 Lin 48)

Friend does not expressly disclose the information processing apparatus according to claim 1 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes a maximum size of the E-mail information and a maximum file size of the attached file.

However, Kakimoto discloses an information processing apparatus wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes the maximum size of the E-mail information and the maximum file size of the file information. (Col 2 Lin 27-37)

There is disclosed a determination means in which the size of the specified data is determined to be smaller or larger than a predetermined size capability of the destination.

The Friend and the Kakimoto Patents are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the predetermined size threshold of the specified E-mail data as specified in the Kakimoto Patent in order to determine the information accommodating capability of the reception terminal as specified in Friend.

The suggestion/motivation for doing so would have been to avoid excessive load on the network because a large size of data is transmitted and can't be accommodated. (Kakimoto, Col 1 Lin 24-27)

Therefore it would have been obvious to combine the Kakimoto Patent with the Friend Patent in order to obtain the invention in claim 7.

16. With respect to claim 13, arguments analogous to those presented for claim 4, are applicable.

17. With respect to claim 14, arguments analogous to those presented for claim 5, are applicable.

18. With respect to claim 16, arguments analogous to those presented for claim 7, are applicable.

19. With respect to claims 22, 23 and 25 15, arguments analogous to those presented for claims 19, 4, 5 and 7, are applicable.

20. With respect to claims 31, 32 and 34, arguments analogous to those presented for claims 28, 4, 5 and 7, are applicable.

Claims 8, 17, 26 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Friend and Kakimoto as specified in claim 7 above, and further in view of US Patent No 6,421,429 to Merritt et al.

21. With respect to claim 8, the combination of Friend and Kakimoto as specified in claim 7 above discloses the information processing apparatus according to claim 6 wherein the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal includes a maximum size of the E-mail, an image format of the attached image file, and a maximum file size of the attached file.

The combination does not expressly disclose that the information accommodating capability includes a *maximum* number of colors of the image corresponding to the image file.

However Merritt discloses an image processing apparatus that determines information accommodating capability of a reception terminal including a maximum number of colors of the image corresponding to said image file. (**Col 10 Lin 35-39**)

The combination of Friend and Kakimoto and the Merritt Patent are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the maximum number of colors of the image corresponding to the image file as specified in the Merritt Patent in order to determine the information accommodating capability of the reception terminal as specified in the combination of Friend and Kakimoto.

The suggestion/motivation for doing so would have been to allow for correct image processing with respect to colors in the transmission of the image data from a transmitting to a receiving terminal.

Therefore it would have been obvious to combine the Merritt Patent with the combination of Friend and Kakimoto in order to obtain the invention in claim 8.

22. With respect to claim 17, please see rejection of claims 8 and 10 above. Additionally the apparatus of claim 8 performs the method of claim 17.
23. With respect to claim 26, please see rejection of claim 8 and 19 above.

24. With respect to claim 35, please see rejection of claims 8 and 28 above.

Additionally the system of claim 19 performs the method of claim 35.

Claims 9, 18, 27 and 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friend as specified in claims 1, 6, 10, 15, 19, 24, 28 and 33 above, in view of US Patent Publication No 2001/0039615 to Bowker et al.

25. With respect to claim 9, Friend discloses the information processing apparatus according to claim 6.

Friend does not expressly disclose the information processing apparatus according to claim 6 wherein, if said image file is a moving image file and the information accommodating capability of said reception terminal or said communication system encompassing said reception terminal corresponds only to a still image file, said information converting means renders one or plural frames making up said moving image file into the attached file attached to said E-mail information.

However, Bowker discloses a data transmission apparatus that translates video to still images when a specific data processing terminal can't accommodate the data format transmitted. (Para [0001] and Para [0006] Lin 1-10)

The Friend Patent and the Bowker Publication are combinable because they are from the same field of endeavor relating to data transmission through a network.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to translate video to still images as specified in the Bowker Publication in order to convert the image file to be transmitted as specified in Friend.

The suggestion/motivation for doing so would have been to allow for the user of the reception terminal to view the image file when the accommodating capability of the terminal does not allow them to view a video or motion image file.

Therefore it would have been obvious to combine Bowker Publication with the Friend Patent in order to obtain the invention in claim 9.

26. With respect to claim 18, please see rejection of claims 9 and 10 above.

Additionally the apparatus of claim 9 performs the method of claim 18.

27. With respect to claim 27, please see rejection of claims 9 and 19 above.

28. With respect to claim 36, please see rejection of claims 19 and 28 above.

Additionally the system of claim 19 performs the method of claim 36.

***Contact Information***

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
August 22, 2007

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Examiner  
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